

Appl. No. : 10/762,843
Filed : January 21, 2004

REMARKS

This is in response to the Office Action mailed January 7, 2005.

As indicated below, in this Action, the Examiner cited as prior art U.S. Patent Publication US 2004/0086318 to Geddes. Submitted herewith is the Declaration of Prior Inventorship Under 37 C.F.R. § 1.131 of Cedora Ruiz. By this Declaration, the Applicant establishes prior inventorship of the present invention, thus negating Geddes as a prior art reference.

Drawings/Specification

By the Action, the Examiner noted that replacement figures must be submitted in order to effect correction of certain reference numbers. By this Response, Applicant has submitted these replacement figures.

The Examiner also requested that the prior application be updated, and noted a grammatical error in Paragraph [0031]. Applicant thanks the Examiner for noting these items and has requested their correction herein.

Claim Rejections - Section 102

By the Action, the Examiner rejected Claims 10 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by Siegel. Applicant respectfully traverses this rejection.

Applicant asserts that Siegel discloses a pen comprising a barrel (11) which defines an interior and an exterior. A ball point cartridge (13) is located in the interior of the barrel (11) (along with a spring (14)). An opaque sleeve (20) which is adapted to carry indicia, such as an advertisement,

Appl. No. : 10/762,843
Filed : January 21, 2004

is located at the exterior of the barrel (11). This sleeve (20) may be protected by a covering sleeve (23), which is also located at the exterior of the barrel (11).

Applicant notes that Claim 10 is directed to a writing implement comprising a housing which defines an interior space which houses both a well containing writing material and a plurality of solid ornamental elements. In this configuration, the plurality of ornamental elements are located within the interior of the housing around the well. In this regard, Applicant asserts that Siegel does not disclose or suggest such a configuration, in that Siegel explicitly discloses a configuration where the sleeve is located at the exterior of the housing.

The Examiner also rejected Claims 10 and 12 as being anticipated by Dirks (USN 4,541,630). Applicant again asserts that Dirks does not disclose or suggest each of the elements of the writing implement claimed in Claim 10. Claim 10 recites a writing implement having a housing with a first end and a second end and an interior area between the ends. A plurality of ornamental elements substantially fills the interior area between the ends.

Dirks discloses a pen with a random number generator. As such, Dirks' pen has body (11). A central member (22) is connected to the top of the body (11). The central member (22) includes a cylindrical portion (24) located in a sleeve (30). A small number of balls (40) are configured to be received at the exterior of the cylindrical portion (24) beneath the sleeve (30), such as in slots (37,38) in the cylindrical portion.

First, Applicant asserts that Dirks does not even disclose a writing implement with a housing defining an interior which houses both ornamental elements and a well of a writing implement. If the body (11) of Dirks is construed as the "housing," then the "housing" of Dirks does not also

Appl. No. : 10/762,843
Filed : January 21, 2004

contain ornamental elements. Dirks does include a cylindrical portion (24) which is connected to the body (11), but the balls (40) are located at the exterior of this cylindrical portion (while the ink well/refill is located at the interior thereof). Dirks also discloses a sleeve (30). While the balls (40) are located within the sleeve, they are not located with an interior space between the well and the sleeve (30), but are instead located between the sleeve (30) and the inner cylindrical member (24).

Applicant also asserts that Dirks also does not disclose a writing implement including a plurality of ornamental elements substantially filling an interior of the housing of the writing implement from a first to a second end - Dirks' body (11) is completely devoid of "ornamental elements," and are simply located at certain exterior portions of the cylindrical portion (24) above the body (11).

Lastly, the Examiner rejected Claims 10 and 12 as being anticipated by Geddes. As indicated above, Applicant has submitted herewith a Declaration of Prior Inventorship Under 37 C.F.R. § 1.131 by which the inventor clearly establishes prior invention of the present invention, thus eliminating Geddes as a potential prior art reference

Claim Rejections - Section 103

The Examiner rejected Claim 11 under 35 U.S.C. § 103 as being unpatentable over Dirks. The Examiner asserts that Dirks teaches all of the elements of the invention except for the size of the ornamental elements. Applicant asserts that because Dirks does not disclose even the basic elements of the invention as claimed in underlying independent Claim 10, Claim 11 is allowable as depending thereon.

Appl. No. : 10/762,843
Filed : January 21, 2004

The Examiner also rejected Claims 11, 13 and 14 as being unpatentable over Geddes. Relative to this rejection, Applicant once again notes that prior inventorship has been established, thus removing Geddes as a potential prior art reference.

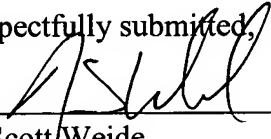
New Claims 15-18

Applicant has presented new Claims 15-18 and asserts that these claims further define the invention over the cited prior art. For example, relative to Claims 15 and 16, Applicant asserts that Siegel does not disclose ornamental elements which can move within the housing. Instead, Siegel simply disclose a sleeve which is fixed to an exterior of the barrel (11) of a pen. Relative to Claim 17, Applicant asserts that Dirks does not disclose a writing implement in which ornamental elements fill an interior area between a tip and a second end of a housing. In Dirks, balls are located only at certain exterior areas of a secondary cylindrical portion of the pen.

Appl. No. : 10/762,843
Filed : January 21, 2004

Summary

Applicants thank the Examiner for the indication that Claims 10-18 are allowable. Applicants assert that these new claims are in a condition for allowance and respectfully request a notice as to the same. If any matters remain outstanding, the Examiner is invited to contact the undersigned by telephone.

Respectfully submitted,
Dated: July 5, 2005 By: 
R. Scott Weide
Registration No. 37,755
Weide & Miller, Ltd.
Bank West Building, 5th Floor
7251 West Lake Mead Blvd., Suite 530
Las Vegas, NV 89128
(702) 382-4804 (Pacific time)

Appl. No. : 10/762,843
Filed : January 21, 2004

IN THE DRAWINGS:

Please replace the sheets of figures with the replacement sheets attached.

By these replacement sheets, Applicant has corrected reference number 134 to number 136 in Figure 4, and has added reference number 240 to Figure 5.